

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner provisionally rejects claims 1-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent Application No. 10/823,814. Furthermore, the Examiner provisionally rejects claims 1-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent Application No. 10/718,189.

In response, the Applicant respectfully traverses the Examiner's rejections under the judicially created doctrine of obviousness-type double patenting for at least the following reasons.

Application Nos. 10/823,814 and 10/718,189 disclose inventions relating to high frequency knives. However, the claims of each of such application is different from claims 1-8 of the present application. Furthermore, as discussed below, claim 1 has been amended to include the features of claim 2. Therefore, Applications respectfully request that the Examiner reconsider the rejections of claims 1-8 under the judicially created doctrine of obviousness-type double patenting in light of amended claim 1 and the comments set forth below.

In the present invention as set forth in independent claim 1, as amended, a plate electrode is disposed on a distal end of the rod electrode part and the plate electrode includes a plane surface extending in a direction crossing the axis direction of the sheath. A plurality of electro-conductive projecting portions are formed on the plate electrode part and project in extending directions different from each other.

In application No. 10/823,814, a liquid supply opening is made in the distal end of the sheath of the high-frequency knife. Although, this application includes a drawing that illustrates an electrode of a similar shape to that of the present application, such an electrode is not directly related to what is claimed. Furthermore, application No. 10/823,814 has a filing date (April 14, 2004) after the filing date (February 12, 2004) of the present application. Therefore, a double-patenting rejection based on application No. 10/823,814 is improper because a terminal disclaimer will not result in disclaiming any term.

With regard to application No. 10/718,189, claim 1 of the same was canceled by an amendment filed on March 3, 2006, thereby rendering this rejection moot. Furthermore, Application No. 10/718,189 claims an insulating member for the electrode of the high-frequency knife. An insulating member is not recited for the electrode of claim 1 of the present application.

Accordingly, the Examiner is respectfully requested to withdraw the rejections of claims 1-8 under the judicially created doctrine of obviousness-type double patenting.

In the Official Action, the Examiner rejects claims 1-3 and 8 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,846,241 to Kittur et al., (hereinafter "Kittur"). Additionally, the Examiner rejects claims 4-7 under 35 U.S.C. § 103(a) as being unpatentable over Kittur in view of U.S. Patent No. 6,379,350 to Sharkey et al., (hereinafter "Sharkey").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below. However, independent claim 1 has been amended to clarify its distinguishing features. The amendment to claim 1 is fully supported in the original disclosure, particularly in original claim 2. Accordingly, claim

2 has been canceled and claims 3 and 4 have been amended to change their dependencies from canceled claim 2 to claim 1. Therefore, no new matter has been entered into the disclosure by way of the amendment to claim 1.

In the present invention as recited in claim 1, a plurality of conductive projecting portions are formed on the plate electrode portion provided at the distal end of the high-frequency knife, and the plate electrode includes a plurality of conductive projection portions project in directions different from each other. With this structure, a living tissue can be hooked on the projecting portions (13b) and then electricity is supplied to the projecting portions to cut the tissue, as can be seen in FIG. 4C and FIG. 6.

In contrast, Kittur discloses a high-frequency knife including a planar electrode; however the planar electrode of Kittur is merely of a disk shape. Further, the “hook portion 50” is made of an insulating chip. Thus, Kittur does not disclose or suggest the plurality of conductive projecting portions formed on the plate electrode. Kittur also does not even disclose or suggest the function of cutting tissue while hooking it on conductive projecting portions. As discussed above, claim 1 has been amended to clarify such distinguishing features.

With regard to the rejection of claims 1-3 and 8 under 35 U.S.C. § 102(b), a high-frequency knife having the features discussed above and as recited in independent claim 1, is nowhere disclosed in Kittur. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>1</sup> independent claim 1 is not anticipated by Kittur. Accordingly, independent claim 1 patentably distinguishes over Kittur and is allowable.

---

<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

Claims 2, 3 and 8 being dependent upon claim 1 are thus at least allowable therewith.

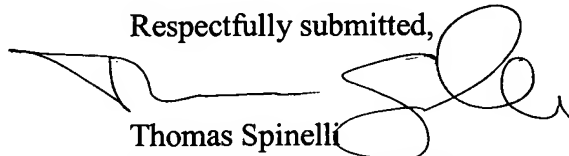
Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-3 and 8 under 35 U.S.C. § 102(b).

With regard to the rejection of claims 4-7 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 4-7 are at least allowable therewith because they depend from an allowable base claim.

In other words, independent claim 1 is not rendered obvious by the cited references because neither the Kittur patent nor the Sharkey patent, whether taken alone or in combination, teach or suggest a high-frequency knife having the features discussed above. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 4-7 being dependent upon claim 1 are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 4-7 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli  
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
(516) 742-4343  
TS:cm